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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,651	03/16/2004	Shusuke Akazaki	107101-00050	1118
4372	7590	04/05/2011		
ARENT FOX LLP 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			EXAMINER NGUYEN, TU MINH	
			ART UNIT 3748	PAPER NUMBER
			NOTIFICATION DATE 04/05/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com

IPMatters@arentfox.com

Patent_Mail@arentfox.com

Office Action Summary

Application No.

10/800,651

Applicant(s)

AKAZAKI ET AL.

Examiner

TU M. NGUYEN

Art Unit

3748

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 7-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 7-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 08/975,101.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. An Applicant's Amendment filed on November 27, 2009 has been entered. Claims 1 and 12 have been amended. Overall, claims 1 and 7-14 are pending in this application.

Oath/Declaration

2. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is currently relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid.

3. Claims 1 and 7-14 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office Action.

4. The oath or declaration submitted on March 16, 2004 is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be "material to patentability as defined in 37 CFR 1.56."

5. Applicant is to file another Oath /Declaration where foreign priority is being claimed in order to fully comply with requirement under 37 CFR 1.55. In this new Oath/Declaration, the reissue foreign priority claim must provide application number, foreign country, and the filing day, month, and year of the foreign application. See MPEP 1417; Reissue Guide #17(g).
6. A new original consent paper must be filed because applicants have not stated that the parent reissue application will be abandoned. A statement under 37 CFR 3.73(b) should accompany the consent. Since this application does not replace the parent reissue application, a new declaration and consent is required. See MPEP 1451(II).

Drawings

7. The abstract and drawings filed are objected to for failing to comply with 37 CFR 1.173(a)(1)(2) which requires applicant to submit the entire specification, including the abstract, in the form of a printed copy of the patent, in double column format and submission of copies of drawing sheets of the patent.

Specification

8. The abstract and drawings filed are objected to for failing to comply with 37 CFR 1.173(a)(1)(2) which requires applicant to submit the entire specification, including the abstract, in the form of a printed copy of the patent, in double column format and submission of copies of drawing sheets of the patent.

The substitute abstract filed on August 3, 2004 is objected to for failing to comply with 37 CFR 1.173(b)(1) which requires applicant to submit amended specification with markings pursuant to section (d) of this section.

9. The disclosure is objected to because it fails to comply with 37 CFR 1.177 (a) since applicant fails to cross-reference the parent reissue application in the first sentence of the specification. 37 CFR 1.177 (a) requires that “If applicant files more than one application for the reissue of a single patent, each such **application must contain or be amended to contain in the first sentence of the specification** a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date..” (bold face added). Therefore, the reissue must be amended to contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identify each of the reissue applications by relationship, application number, and filing date. Applicant must state that this reissue application “is a continuation reissue application” of its parent reissue application. 37 CFR 1.173(b)(1) further requires underlining all paragraphs which are added to the specification of the original patent.

Appropriate correction is required.

Claim Objections

10. The amendment filed on October 27, 2009 proposes amendments to claim 1 that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required. The amended claim 1 is improper because the changes (i.e., markings, bracketing, and underlining)

appear to have been made relative to current issue application rather than being made relative to the patent claims to be reissued. For example, “wherein the improvement comprises...” that applicant deleted from the patent claim 1 is not shown in brackets in the reissue claim; and, newly added claim language in claim 1 with respect to the “valve control means” (e.g., “to open the bypass”) is not underlined, as required by 37 CFR 1.173(d).

Claim Rejections - 35 USC § 251

11. Claims 1 and 7-14 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. In the most recently amendment filed on October 27, 2009, amended claim 1 does not include the phrase “wherein the improvement comprises: the valve means is provided adjacent the branching point ... the conduit is connected to the bypass at end of the chamber”, which was present in the U.S. Patent 5,946,906. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Communication

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tu Nguyen whose telephone number is (571) 272-4862.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Thomas E. Denion, can be reached on (571) 272-4859. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TMN

March 29, 2011

/Tu M. Nguyen/

Tu M. Nguyen

Primary Examiner

Art Unit 3748